

REMARKS

In the Office Action¹, the Examiner rejected claims 1 and 7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,794,207 to Walker et al. (“Walker ‘207”) in view of U.S. Patent No. 5,862,223 to Walker et al. (“Walker ‘223”) and further in view of U.S. Patent No. 5,589,892 to Knee et al. (“Knee”). Applicant respectfully traverses the Examiner’s rejection.

By this Amendment, Applicants amend independent claims 1 and 7, and add new dependent claims 13-26, to more particularly define the scope of the invention. Claims 1, 7, and 13-26 are pending.

Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1 and 7 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established with respect to claims 1 and 7. A *prima facie* case of obviousness has not been established because, at least, the prior art does not suggest the desirability of the claimed invention.

The prior art cited in the Office Action does not provide a motivation to combine the references as suggested by the Examiner. Claim 1 recites a combination including, for example:

An information processing apparatus ... comprising:

...

recording means for recording a request information transmitted by a first user authenticated by said authenticating means; wherein said first user is a customer and said request information is a *non-binding request for an offer to sell goods* matching the request to said consumer;

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

(emphasis added). However, *Walker* '207 teaches "a key element necessary to achieve a critical mass of seller participation ... is the seller's ability to bind a buyer to a legal contract under the terms of the buyer's posted offer" (col. 4, lines 13-16). *Walker* '207 continues, "In contrast to a non-binding request for proposal, a binding offer from a buyer is attractive to potential sellers" (col. 4, lines 16-18). Indeed, acceptance of *Walker*'s conditional purchase offer, relied upon by the Examiner, leads to a "legally binding contract" (col. 9, lines 27-30). *Walker* '207 thus teaches away from the claimed subject matter.

Some sellers are willing to participate in a commercial system even when the information they receive from a buyer is not a binding contract. For these sellers, the claimed system provides substantial advantages. The seller in the claimed invention would have access to a customer base that provides reliable customer information, and automates and centralizes customers' requests for information. While the seller in the claimed invention is not guaranteed that the buyer has a contractual obligation as in the *Walker* '207 system, the seller obtains the advantage of access to a group of customers who are both interested in the seller's products and authenticated for reliability.

Moreover, the buyers in the claimed system have a significant advantage over the buyers in the *Walker* system. Buyers who are not willing to bind themselves to a contract in order to obtain information from sellers are still able to interact with sellers. This has the advantage of attracting significant buyer participation. Buyers using the claimed system can receive multiple offers from different sellers and choose one of the offers, rather than being forced to contractually obligate themselves in order to obtain

information.

Increased buyer participation, in turn, constitutes another benefit for sellers.

In this manner, claim 1 combines the elements recited to achieve significant advantages to both buyers and sellers. As discussed above, *Walker* '207 fails to suggest the desirability of, and in fact discourages, the subject matter of claim 1. Therefore, one of ordinary skill in the art would not have been motivated to combine *Walker* '207 with *Walker* '223 and *Knee* to obtain the claimed combination. Moreover, *Walker* '223 and *Knee* fail to cure the deficiencies of *Walker* '207.

Although of different scope, independent claim 7 recites features similar to those of claim 1. As already discussed, none of the prior art references cited by the examiner suggest the desirability of combining the features recited by these claims.

Because none of the cited prior art references suggests the desirability of the combined elements in claims 1 and 7, a *prima facie* case of obviousness has not been established for these claims. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. § 103(a) and allow claims 1 and 7.

New claims 13-19 depend from claim 1, and new claims 20-26 depend from claim 7. Applicant believes the new claims are allowable at least for the reasons discussed above regarding independent claims 1 and 7.

Claims 15-19 and 22-26 present elements that were previously included in amended claims 1 and 7, respectively, and are now removed from the independent claims and placed in dependent form. However, dependent claims 13, 14, 20, and 21 are directed to subject matter that was not previously captured in a dependent claim.

Claim 13 recites "the information processing apparatus according to claim 1, wherein the searching means allows a customer to search request information submitted by other customers". Support for this claim can be found, for example, at p. 14 of the specification. Claim 14 recites "the information processing apparatus according to claim 1, wherein the customer can purchase goods using request information from other users". Support for this claim can be found, for example, at p. 16 of the specification. Claims 20 and 21 recite similar elements as method. Applicant submits that the elements described in these claims is not disclosed in the prior art of record, and accordingly requests allowance of these claims.

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 23, 2005

By: 
Michael R. Kelly
Reg. No. 33,921